

REMARKS

Prior to entry of this amendment, claims 1-4 are pending in the subject application. Claims 1 and 4 are independent. Claims 5-20 are added. Support for claims 5 and 13 may be found in paragraphs [0036] and [0038] of the specification. Support for claims 6, 7, 14 and 15 may be found in paragraph [0038] of the specification. Support for claims 8, 9, 16 and 17 may be found in paragraph [0037] of the specification. Support for claims 10 and 18 may be found in paragraph [0041] of the specification. Support for claims 11, 12, 19 and 20 may be found in paragraph [0042] of the specification. No new matter is added.

Applicants note with appreciation the Examiner's acknowledgement of applicants' claim for foreign priority and receipt of a certified copy of the priority document.

Applicants further note with appreciation the Examiner's acceptance of the drawings filed on July 14, 2003.

Applicants further note with appreciation the Examiner's consideration of applicants' Information Disclosure Statement filed November 30, 2004.

A. Introduction

In the outstanding Office Action, the Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph as being indefinite; rejected claims 1, 3 and 4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,566,125 to Clunn ("the Clunn reference"); and rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the Clunn reference.

B. Asserted Anticipation Rejection of Claims 1, 3 and 4

In the outstanding Office Action, the Examiner rejected claims 1, 3 and 4 under 35 U.S.C. § 102(b) as being anticipated by the Clunn reference. This rejection is respectfully traversed for at least the reasons set forth below.

The present invention pertains to a method for recognizing a pattern of an alignment mark. As set forth in independent claim 1, the present invention sets forth a novel combination of steps, which includes, "deleting image data from a region where the alignment pattern does not exist between the captured images." As set forth in independent claim 4, the present invention sets forth a novel combination of steps, which includes, "capturing an image by magnifying only the identified key alignment mark."

The Clunn reference pertains to an apparatus and method for pattern recognition. At page 3, lines 4-6, of the Office Action the Examiner asserts that FIG. 4, step 478, of the Clunn reference describes, "deleting image data from a region where the alignment pattern does not exist between the captured images by deleting the area in the initial area that doesn't have the mark." FIG. 4 of the Clunn reference is reproduced below.

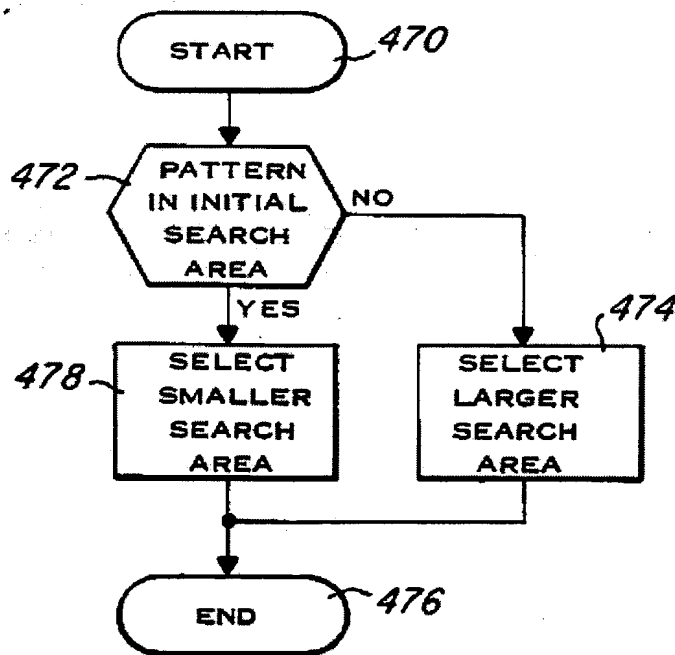


Fig. 4

Step 478 of the Clunn reference is only labeled "Select Smaller Search Area." There is no teaching or suggestion in FIG. 4 of the Clunn reference (or anywhere else in the Clunn reference) of "deleting image data from a region where the alignment pattern does not exist between the captured images," such as is set forth in claim 1 of the present application. The Chun reference thus fails to teach or suggest each and every limitation of claim 1 of the present invention. As a result, the Clunn reference fails to anticipate claim 1 of the present invention. Claims depending upon claim 1 are patentable for at least the above reasons.

Regarding independent claim 4, at page 3, lines 17-18, of the Office Action, the Examiner asserts that FIG. 4, step 478, of the Clunn reference (reproduced above) describes "capturing an image by magnifying only the identified key alignment mark by searching a smaller area." Step 478 of the Clunn reference is only labeled "Select Smaller Search Area." However there is no teaching or suggestion in FIG. 4 of the Clunn reference (or anywhere else in the Clunn reference) of "capturing an image by magnifying only the identified key alignment mark," such as is set forth in claim 4 of the present application. The Chun reference thus fails to teach or suggest each and every limitation of claim 4 of the present invention. As a result, the Clunn reference fails to anticipate claim 4 of the present invention. Claims depending upon claim 4 are patentable for at least the above reasons.

For the above reasons, applicants respectfully submit that the rejection of claims 1, 3 and 4 under 35 U.S.C. § 102(b) has been traversed, and favorable reconsideration and withdrawal thereof is respectfully requested.

C. Asserted Obviousness Rejection of Claim 2

In the outstanding Office Action, the Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the Clunn reference. This rejection is respectfully traversed for at least the reasons set forth below.

At page 4, line 12, of the Office Action, the Examiner unequivocally admits to at least one of the failures of the Clunn reference, stating, “Clunn does not disclose expressly that the mark is magnified by about four times.” The Examiner then asserts that this limitation would be obvious to one of ordinary skill.

Applicants respectfully submit that claim 2 is allowable as depending from an allowable independent claim. Moreover, the Examiner has relied upon the single Clunn reference to assert obviousness. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *MPEP* § 2143. In addition, if a reference needs to be modified to achieve the claimed invention “there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion.” *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 225 F.3d 1349, 55 USPQ2d 1927 (Fed. Cir. 2000).

In this case, other than the naked assertion that it would have been obvious, the Examiner has failed to show where in the single Clunn reference itself resides a teaching or suggestion of “at least about four magnifications.” Accordingly, absent the Examiner’s assertion that it would have been obvious, one of ordinary skill in the art would not be motivated by the Clunn reference to produce claim 2 of the present application. Even with the Examiner’s assertion that it would have been obvious, there is nothing in the Clunn reference that would motivate one of skill in the art to take a “key alignment mask” and magnify “by at least about four magnifications.”

Accordingly, applicants respectfully submit that a *prima facie* case of obviousness has thus not been made as to claim 2.

For the above reasons, applicants respectfully submit that the rejection of claim 2 under 35 U.S.C. § 103(a) has been traversed, and favorable reconsideration and withdrawal thereof is respectfully requested.

D. Asserted Indefiniteness Rejection of Claim 3

In the outstanding Office Action, the Examiner rejected claim 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully traverse this rejection for at least the reasons set forth below.

At page 2, lines 9-12, of the Office Action, the Examiner asserts that claim 3 lacks full antecedent basis. However, claim 3 has been amended to be clear, definite and have full antecedent basis.

For the above reasons, applicants respectfully submit that this rejection under 35 U.S.C. § 112, second paragraph, has been traversed, and reconsideration and withdrawal thereof is respectfully requested.

E. Conclusion

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested.



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Respectfully submitted,
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PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.